

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

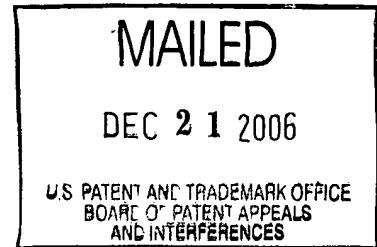
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY G. WILEY

Appeal No. 2006-3037
Application No. 10/033,225

ON BRIEF



Before JERRY SMITH, BARRY, and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 4-12, and 14-27, which constitute all the claims pending in this application.

The disclosed invention pertains to a multifunction device that may be used to convert paper documents and then transmit the electronic image to a variety of network destinations. Specifically, the multifunction device enables a user to specify a remote storage device having a particular electronic document. To this end, the user identifies the user-specified remote storage device based in part on a path thereto specified by the user. After establishing a link between the

multifunction device and the user-specified remote storage device, the electronic document is accessed over the link. The electronic document is then sent to certain destinations from the multifunction device.

Representative claim 1 is reproduced as follows:

1. A method for providing access from a multifunction device to an electronic document at a user-specified remote storage device, comprising:
 - identifying said user-specified remote storage device having said electronic document based at least in part on a path thereto specified by a user at said multifunction device;
 - establishing a link between said multifunction device and a user-specified remote storage device having said electronic document;
 - accessing said electronic document at said user-specified remote storage device from said multifunction device over said link established therebetween; and
 - sending said electronic document from said multifunction device.

The examiner relies on the following reference:

Czyszczewski et al. (Czyszczewski) 6,577,907 June 10, 2003
(Filed April 24, 2000)

The following rejection¹ is on appeal before us:

Claims 1, 4-12, and 14-27 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Czyszczewski.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

¹ Although arguments were presented in the brief regarding a previous rejection of claims 1 and 12 under 35 U.S.C. § 101 [see brief, pages 5 and 6], the examiner subsequently withdrew this rejection [see answer, page 3; reply brief, page 3].

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Czyszczewski fully meets the invention as set forth in claims 1, 4, 7-12, 14, 17-25, and 27. We reach the opposite conclusion, however, with respect to claims 5, 6, 15, 16, and 26. Accordingly, we affirm-in-part.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner has indicated how the claimed invention is deemed to be fully met by the disclosure of Czyszczewski [answer, pages 3-9]. Regarding independent claims 1, 12, and 21, appellant argues that even though the multifunction device disclosed in Czyszczewski accesses remote datastores, the reference does not teach a user-specified remote storage device. Appellant emphasizes that the multifunction controller's access to remote datastores in Czyszczewski is

limited and controlled by the remote administrator's database. Furthermore, access is limited to predetermined links to the remote datastores [brief, page 8; reply brief, page 4]. Accordingly, Czyszczewski fails to teach or suggest identifying a user-specified remote storage device having the electronic document based at least in part on a path specified by a user as claimed [brief, pages 7, 8, 11, and 12]. The examiner argues that retrieving a document from a remote datastore inherently requires the user to specify the remote storage device [answer, pages 10 and 11].

We will sustain the examiner's rejection of independent claims 1, 12, and 21.

Czyszczewski's multifunction device, among other things, enables the user to access a document from one of the optional global services 55 via global network 50. The user then selects at least one destination for the document and then sends the document to the destination(s) [Czyszczewski, col. 7, lines 12-25]. The optional global services 55 are shown in detail in Fig. 4 and include databases 150 [Czyszczewski, Fig. 4; col. 6, lines 50-56]. In Fig. 5, Czyszczewski illustrates exemplary databases 150 that comprise at least part of the optional global services. Significantly, the databases include (1) a forms website 170 that enables users to access standard enterprise forms, and (2) remote database storage 175 that provides various types of information that may be useful to users [Czyszczewski, col. 9, lines 20-38].

In our view, enabling the user to access at least the forms website in Czyszczewski inherently requires the user to specify the path at the multifunction device. Essentially, the forms website is a "user-specified remote storage device" since the user inherently specifies that particular storage device (*i.e.*, the forms website) when a form is desired. Significantly, the user accesses the forms website via a global network, such as the Internet [see Czyszczewski, col. 5, line 63 – col. 6, line 2]. In our view, the specified path to a desired form would be dictated by

the protocol used by the global network (e.g., a uniform resource identifier (URL) used in hypertext transfer protocol).

Czyszczewski in Fig. 9F shows the multifunction device's graphical user interface when the user selects the "Library" tab. As the figure indicates, the user can specify unique individual forms from a list of forms. Upon selection, the device will retrieve the selected form from the forms website [Czyszczewski, col. 13, lines 10-18; col. 12, lines 28-32].

Although the user does not directly enter a URL for the desired form in the multifunction device in this mode, the document's path is nevertheless inherently specified since the multifunction device must access and retrieve the selected document from the forms website via the global network. In short, selecting the form inherently selects a path to the form.

Even if the content available to the user is ultimately controlled by an administrator as appellant argues, the user nevertheless inherently specifies the path to such content by selecting an available form as noted above. Moreover, the scope and breadth of the limitation "user-specified remote storage device" does not preclude a remote storage device that may have limited access, but nevertheless can be specified by the user. In this regard, even predetermined links to the forms website 170 and remote database 175 would render such remote datastores "user-specified" since a unique datastore -- and the path thereto via the global network -- would be inherently specified depending on the specific type of data the user desired to access.

Because Czyszczewski expressly and inherently discloses all recited limitations of independent claims 1, 12, and 21, the examiner's anticipation rejection of those claims will therefore be sustained. Since appellant has not separately argued the patentability of dependent claims 4, 7-11, 14, 17-20, 22-25, and 27 with particularity, these claims fall with the independent

claims. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). See also 37 CFR § 41.37(c) (I) (vii).

Regarding claims 5, 6,² 15, 16, and 26, appellant argues that Czyszczewski does not disclose combining an electronic document generated at the multifunction device with an electronic document the user-specified remote storage device as claimed [brief, pages 9-13; reply brief, pages 6, 7, and 9-11]. The examiner responds that Czyszczewski's multifunction device periodically checks the website to ensure that it has a current list of documents and that this feature meets the limitation calling for combining electronic documents as claimed [answer, pages 12-16].

We will not sustain the examiner's anticipation rejection of claims 5, 6, 15, 16, and 26. We agree with appellant that Czyszczewski does not expressly or inherently disclose combining electronic documents generated at the multifunction device with electronic documents from the user-specified remote storage device as claimed. Czyszczewski's multifunction device periodically checks the website to ensure it has a current document list so that the most current documents are dynamically downloaded upon request [Czyszczewski, col. 10, lines 59-63]. Such a feature, however, hardly teaches combining locally-generated electronic documents with other electronic documents accessed from a user-specified remote storage device as claimed. Although Czyszczewski's multifunction device can process both locally-generated electronic documents and electronic documents accessed from remote sites, there is simply nothing in Czyszczewski that teaches combining such diverse electronic documents. At best, the respective documents are

² In the claims appendix, claim 6 recites in pertinent part "...combining said accessed data said electronic document from said user-specified remote storage device...." [claims appendix, emphasis added]. The limitation "said accessed data," however, was previously deleted in the amendment filed Apr. 21, 2005. Accordingly, we presume that the inclusion of "said accessed data" in the listing of claim 6 in the brief was an inadvertent typographical error.

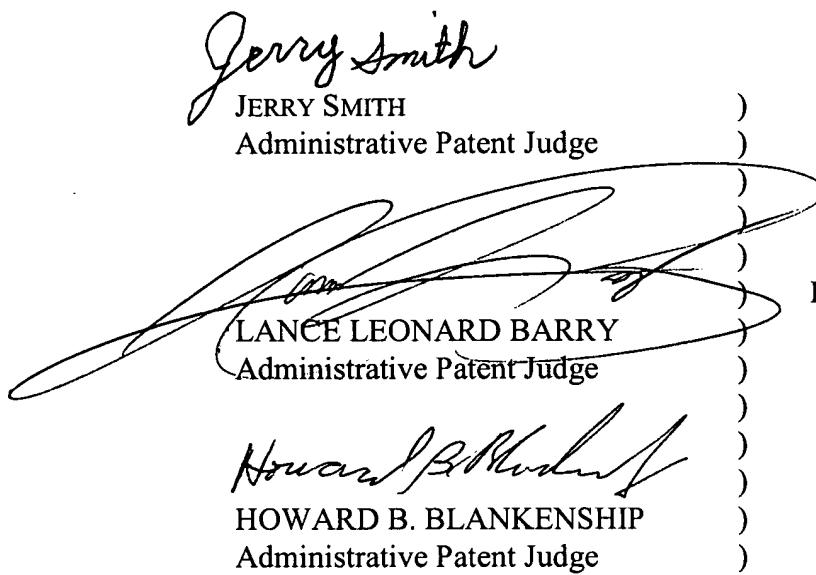
independently processed and sent to remote destinations. Accordingly, Czyszczewski fails to disclose each and every limitation of claims 5, 6, 15, 16, and 26. The examiner's rejection of those claims is therefore reversed.

In summary, we have sustained the examiner's rejection with respect to claims 1, 4, 7-12, 14, 17-25, and 27. We have not, however, sustained the examiner's rejection of claims 5, 6, 15, 16, and 26. Therefore, the decision of the examiner rejecting claims 1, 4-12, and 14-27 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART



JERRY SMITH)
Administrative Patent Judge)
LANCE LEONARD BARRY)
Administrative Patent Judge)
HOWARD B. BLANKENSHIP)
Administrative Patent Judge)

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